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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN C. COFANO,
WILLIAM E. CROUNSE,
TIM P. GELINAS,
MICHELLE NITZ-WEISS, and
KENNETH D. GRAHAM

Appeal 2009-012366
Application 09/862,472
Technology Center 3600

Decided: November 25, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

John C. Cofano, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-7, 9, 16-21, and 25-27. Claims 8, 10-15, and 22-24 have been cancelled and claims 28-66 have been withdrawn. *See* Br. 3. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

“The invention relates to automated systems for providing personal services.” Specification [0002]

Claim 20, reproduced below, is illustrative of the subject matter on appeal.

20. A system for providing personal services over a computer network to members of at least one of a plurality of predefined groups, the system comprising:
a user interface unit that receives a service request from a user who is a member of one of the groups and determining a user type associated with the service request;
a server unit that:
provides, to the user, a menu of service request options based on the user type,
receives a user-selected service request option through the user interface unit,
determines a service response to the user-selected service request option,

¹ Our decision will make reference to the Appellants’ Appeal Brief (“Br.,” filed Dec. 12, 2008) and the Examiner’s Answer (“Answer,” mailed Mar. 24, 2009).

provides personal services to the user in accordance with the determined service response, and

inserts at least one reminder related to the personal services into an electronic calendar associated with the user; and

a data storage unit that records interactions while providing the determined service response and that presents statistical information related to the interactions to an administrator associated with the one group.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Joao US 6,283,761 B1 Sep. 4, 2001

The following rejections are before us for review:

1. Claims 1-7, 9, and 16-19 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.
2. Claims 19-21 and 25-27 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.
3. Claims 1-7, 9, 16-21, and 25-27 are rejected under 35 U.S.C. §102(b) as being anticipated by Joao.

DISPOSITION OF THE APPEAL

The Examiner entered a new ground of rejection in the Examiner's Answer against claims 1-7, 9, and 16-19 under 35 U.S.C. §101 as being directed to nonstatutory subject matter. Answer 3. The Examiner properly gave notice of the new ground of rejection (Answer 14) and the Technology Center Director approved it. Answer 15. As the Answer indicated (Answer 14), the Appellants were required to respond to the new grounds within two

months in either of two ways: 1) reopen prosecution (*see* 37 CFR 41.39(a)(2)(b)(1)); or 2) maintain the appeal by filing a reply brief as set forth in 37 CFR 41.41 (*see* 37 CFR 41.39(a)(2)(b)(2)), “to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection.” Answer 14. According to the record before us, neither option appears to have been exercised.

Accordingly, the appeal as to claims 1-7, 9, and 16-19, subject to the new ground of rejection under §101 as being directed to nonstatutory subject matter stands dismissed.

Upon return of the application to the Examiner, the Examiner should (1) cancel claims 1-7, 9, and 16-19 subject to the new ground of rejection and (2) notify the Appellants that the appeal as to claims 1-7, 9, and 16-19, subject to the new ground of rejection under §101, as being directed to nonstatutory subject matter, is dismissed and claims 1-7, 9, and 16-19 are cancelled. *See* Manual of Patent Examining Procedure (MPEP) § 1207.03, 8th ed., Rev. 7, Jul. 2008.

Given that the appeal as to claims 1-7, 9, and 16-19 stands dismissed, the rejections before us for review are reduced to as follows:

1. Claims 20, 21, and 25-27 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. *See* Answer 5.
2. Claims 20, 21, and 25-27 are rejected under 35 U.S.C. §102(b) as being anticipated by Joao. *See* Answer 8.

ISSUES

The issues are whether the Appellants have shown error in the Examiner's rejections of claims 20, 21, and 25-27 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement and claims 20, 21, and 25-27 under 35 U.S.C. §102(b) as being anticipated by Joao.

FINDINGS OF FACT

We rely on the Examiner's factual findings stated in the Answer (Ans. 9-10) and Final Office Action (4-5).

PRINCIPLES OF LAW

Enablement

"[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without [']undue experimentation.[']" *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993) (citation omitted).

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

ANALYSIS

The rejection of claims 20, 21, and 25-27 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement

We will affirm this rejection because the Appellants' arguments do not respond to the Examiner's rejection. The Appellants' arguments go to whether there is adequate written descriptive support for the claimed invention. *See e.g.*, Br. 8 ("there is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed."). However, the Examiner was clear in raising a question of compliance with the *enablement* requirement of 35 USC § 112, first paragraph. *See* Final Rejection 3. "There is not a teaching in the specification that would enable one of ordinary skill to build a system and medium with a code that could determine a response." The Appellants have not challenged the rejection with any explanation or evidence in rebuttal showing that the Specification enables one of ordinary skill in the art to make and use the full scope of the claimed invention without undue experimentation.

The rejection of claims 20, 21, and 25-27 under 35 U.S.C. §102(b) as being anticipated by Joao.

The Appellants argue that Joao does not anticipate the claimed subject matter because a server unit that (a) "provides, to the use, a menu of service request options based on the user type" (Br. 10); (b) "inserts at least one reminder related to the personal services into an electronic calendar associated with the use" (Br. 11) are not described.

However, the Appellants do not appear to dispute the Examiner's characterization of Joao as describing these limitations.

The Examiner has taken the position that Joao describes the "menu of service request options" claim limitation at col. 25, ll. 5-65, col. 4, ll. 38-40,

col. 39, ll. 55-60, and col. 39, ll. 10-20 (Final Rejection 4) and Fig. 15A, col. 19, ll. 8-12, and col. 19, ll. 35-40 (Answer 9).

According to the Examiner, Joao describes the “inserts at least one reminder ... into an electronic calendar” claim limitation at col. 32, ll. 65-68, col. 33, ll. 15-20, col. 24, ll. 25-30, col. 5, ll. 10-18 and ll. 35-40, col. 6, ll. 20-25 and ll. 50-55, col. 3, ll. 1-14. Final Rejection 5 and Answer 10.

The Appellants do not dispute the Examiner’s characterization of what these passages disclose. Rather, the Appellants argue that the Joao does not describe the “emailing a calendar appointment request [that] is distinct from inserting an appointment reminder into the calendar” Br. 11.

The independent claims [i.e., claim 20] recite the inserting of an appointment related to personal services into an electronic calendar associated with a user. As a result, there is no point in having the user confirm an appointment, via email, that the user himself/herself is actually making, as described by Joao.
Br. 11.

The Appellants’ argument that the claimed subject matter distinguishes from what Joao describes because the claimed subject matter inserts an appointment reminder into a calendar that would be distinct from emailing a calendar appointment request is not commensurate in scope with what is claimed in claim 20. Claim 20 is an apparatus claim. The question with respect to claim 20 should be whether the server unit Joao describes would function as claimed, not as the Appellants expresses it; that is, whether Joao describes conducting a step that would be distinct from another step. Notwithstanding that the Appellants have not appreciated that the claimed subject matter is directed to an apparatus rather than a process, the distinction argued over, *i.e.*, that inserting an appointment reminder into the

calendar as claimed is distinct from mailing a calendar appointment request, is not reflected in the claim. Nothing in the claim precludes the server from inserting an appointment reminder into the calendar via the use of email. The scope of claim 20 is much broader than the construction the Appellants would have us give it. *Cf. In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) “Many of appellant’s arguments fail from the outset because, . . . they are not based on limitations appearing in the claims . . .” .

CONCLUSIONS

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 20, 21, and 25-27 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement, and claims 20, 21, and 25-27 under 35 U.S.C. §102(b) as being anticipated by Joao.

DECISION

The decision of the Examiner to reject claims 1-7, 9, 16-21, and 25-27 is affirmed.

AFFIRMED

mev

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